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James Marggraff

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EXAMINER

GISHNOCK, NIKOLAI A

ART UNIT

PAPER NUMBER

3715

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/803,806	<b>Applicant(s)</b> MARGGRAFF ET AL.	
	<b>Examiner</b> NIKOLAI A. GISHNOCK	<b>Art Unit</b> 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 38-44, 46-48, 50-60 and 62-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-44, 46-48, 50-60 and 62-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :9/25/2009, 11/4/2009, & 2/19/2010.

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## DETAILED ACTION

In response to reply filed 12/21/2009, claims 1-37, 45, 49, & 61 are cancelled. Claims 38-44, 46-48, 50-60, & 62-75 are pending.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 40-44, 47-49, 52-55, 57, 59, 60, 63-67, 69, & 71-75 are rejected under 35

U.S.C. 102(e) as being anticipated by Blume (US 6,915,103 B2), hereinafter referred to as Blume.

3. Blume discloses a computing device and computer readable media for implementing a method for providing instructional response, comprising: an input device operable to read a first and a second plurality of substantially invisible codes disposed on a surface (user identifies the book and page number, then taps the stylus, 3:32-44), wherein a the print elements are disposed substantially invisible codes (3:57-4:9), and wherein said first and said second plurality of substantially invisible codes provide location information of said first and said second print elements respectively (substantially invisible machine-readable coordinate grid, 3:57-4:9), wherein said receiving is responsive to a user selection of said first print element via an input device (3:44-56); a processor for processing substantially invisible codes (4:46-5:5), wherein

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said processing comprises: determining a first position associated with said first print element responsive to a user selection thereof (3:18-30); and in response to said determining said first position, mapping said first position to a location in memory that a first instructional response associated with said first location is stored (index to database of information, 3:32-44), wherein said first instructional response is an instruction from said computing device for use by a user of said computing device (The system can be used for interactive applications, such as tests, automatically updated newspapers, and speed-reading training. For example, a multiple choice test may be printed on the special paper, such that a student simply selects their chosen answers by tapping on the selected answer. Audio feedback {such as through audio headphones} could be provided for purposes such as to give the definition of a word in a test question, or to confirm which answer the student has actually selected, 7:45-54; also, such as, "turn the page when you hear the BEEP, 1:29-35); and an output device for outputting said first instructional response (audio speaker, 4:46-5:5), wherein said input device, said processor and said output device reside in a same housing (4:46-5:5) [Claims 57, 69, & 73-75].

4. Blume discloses a stylus having an optical detector for detecting said first and said second plurality of substantially invisible codes printed on said surface (detector, 3:18-30), a memory unit comprising code for audio outputs corresponding to the said first and said second print elements element (ROM or RAM, 5:64-6:6) [Claims 40, 52, & 64], and a processor coupled to the optical detector [Claims 40 & 64] (microprocessor, 4:46-5:5) [Claims 40, 52, & 64].

5. Blume discloses wherein the output device is an audio output device operable to output an audio instructional response associated with plurality of substantially invisible codes [Claims 41, 43, 53, 55, 65, & 67], wherein a task is audibly presented to the user by the audio output device [Claims 42, 54, & 66], and wherein the first instructional response relates to a task

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presented to the user [Claims 47, 59, & 71]. ("turn the page when you hear the BEEP, 1:29-35; **see also tests, 7:32-54**) [Claims 41-43, 47, 53-55, 59, 65-67, & 71].

6. Blume discloses wherein the computing device is a writing device (a stylus, 3:7-17) and wherein the processor, the input device, the output device, and the writing device form a housing having a pen-like appearance (3:7-17 & 4:46-5:5; the housing disclosed by Blume in Figures 1 & 2 is understood to be a single unit) [Claims 48, 60, & 72].

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 38, 39, 46, 50, 51, 56, 58, 62, 68, & 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blume, in view of Kardach (US 2003/0001020 A1), hereinafter referred to as Kardach.

10. Blume teaches all the features of Claims 41, 53, 65, & 73-75, as demonstrated above. What Blume fails to teach is wherein the unstructured user input comprises a first print element is a non-keyboard [Claims 46, 58, & 70] user created [Claims 38, 50 & 62] element, created by

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the user on said surface [Claim 38], where the device has a writing element [Claims 39, 51, & 63], wherein said surface is a writing surface [Claims 44, 56, & 68]. However, Kardach teaches a method and apparatus for taking an electronic application program's output and printing them on a piece of paper having a preprinted pattern thereon, thereby creating a hardcopy representation. The hardcopy representation of the application includes a unique ID, which associates the application printed on the page with the preprinted pattern on the paper. Using a special pen, edits may be made to the hardcopy representation. The pen records these edits and sends the updates to a computer system automatically. In response to the receiving the edits, the computer system updates the electronic application automatically (Abstract). A pen may be used to make edits to the hardcopy representation. The pen includes an inkwell for dispensing ink from the pen, a camera to create images of the unique pattern on the hardcopy representation as well as the ID, and a processor coupled to the camera to control the operation of the camera. When the pen draws a line across the ID icon, it reads the ID pattern and then the paper pattern, which are both part of this larger pattern. The ID icon pattern location will be associated with the printed application, while the paper pattern will be associated with a blank page function. When the pen recognizes a pen stroke between these two pattern areas, the local composer will then associate that paper pattern with the meaning assigned it via the ID pattern. During the creation of the paper application {i.e., when it was printed}, the computer will have stored paper pattern information associated with the functions to be performed {e.g., writing in this pattern area means to create an appointment} (Para. 0033-34, see also Figure 5, Item 501). The stylus taught by Blume would contain an ink writing element disposed therein, to be used in the manner taught by Kardash for editing a document electronically with a visible, written pen stroke. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have implemented the ink writing element disposed in the

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pen taught by Kardash, for a user to create an unstructured user input print element on the writing surface taught by Blume, in order to associate a printed piece of paper with an application in an ad-hoc fashion [Claims 38, 39, 46, 50, 51, 56, 58, 62, 68, & 70].

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 37-72 have been considered but are not persuasive. Regarding applicant's comment that the rationale for rejecting claims 38, 39, 44, 46, 50, 51, 56, 58, 62, 63, 68, & 70 were provided, in the previous office action, under §103(a), note that the heading has been adjusted to reflect the rejection as set forth. The rationale as set forth in the descriptive paragraphs following the heading under §102(e) of office action of 9/22/2009, see paragraphs 3-6, was written as intended.

12. Applicant argues that Blume fails to disclose as the same invention when Blume (at 1:31-32) discloses "turn the page when you hear the BEEP"; thus, applicant argues, Blume fails to teach providing a first instruction for use by a user of a computing device, in response to determining the first position resulting from a user selection of a first print element. Applicant goes on to suggest that two different embodiments of the same invention are not arranged in the same fashion, and thus not anticipated by Blume. However, Blume never describes the "conventional" audio book (of 1:29-35) as a separate embodiment of the invention, but as a typical use of a synchronized soundtrack within a conventional audio book. Blume discloses all the features of the instant device of claim 73, as demonstrated above, including an instruction for the user to use, i.e. turn the page. A prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness; however, "the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat



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inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). If the claims would have been obvious over the prior art because what the reference taught was useful for applicant’s purpose, applicant did not distinguish the claims over the prior art, and applicant asserted no discovery beyond what was known to the art. Furthermore, “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). See MPEP 2145(X)(C)(1). Even if this was a separate “embodiment of the invention”, *arguendo*, it is not any kind of teaching away or otherwise for a conventional book used in Blume to instruct a reader to “turn the page at the BEEP”, because Blume teaches many other embodiments that are not mutually exclusive and clearly are used in the same product. The same product of Blume as disclosed is understood to be compatible with all of special paper, bar codes, Optical Character Recognition (OCR), etc. because all these are merely software “embodiments”; that is, the general purpose processor clearly maintains the same structure while performing the different functions as needed. Hence, these embodiments of Blume are actually different aspects of the same device. As proof, note claim 6 of Blume, which requires a system in accordance with claim 1 (requiring a machine-readable coordinate grid) and further including OCR software. These claims all represent the same device of Blume; as such, Blume is understood to disclose conventional book content, including an instruction to turn the page after a beep or other audio signal, in order to follow along in the book while hearing the sounds or seeing visual content depictions of the content. This is not a teaching away, because at no line does Blume state or imply that the disclosed system cannot provide this instruction; what Blume says is they generally require the reader to progress at the pace of an *uninterrupted* or *continuous* synchronized recording (e.g., a record or

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cassette tape), which is completely unlike the strings of recordings Blume discloses (at 3:44-56). Applicant is insinuating that Blume discloses a system that cannot tell the user to turn the page given an audio cue, such as is used in a conventional audio book; this is incorrect, because all Blume says is that having heard the beep, one would be instructed to turn the page. Hence, the limitations of claim 73 are anticipated by Blume because they are arranged as in the claim, as required.

13. Second, Blume discloses (at 2:50-65) that the audio output may be a spoken representation of words on the page, a spoken translation of words on the page, a spoken definition of words or symbols on the page, musical flourishes or sound effects corresponding to words, symbols or illustrations on the page, audio recordings of statements, quotes, events, or other news items, the performance of musical notes on the page, or any other audio and/or video output that enhances the use or effect of the printed matter; and video in this context can represent anything that might appear on a computer or television screen including additional text, animations, and imagery, both still and moving; and that the audio and/or video may be non-interactive or presented interactively. It is understood that presenting audio interactively means giving a user an instruction to use. This is clearly done in response to determining a position of a print element (recited at 3:31-43). Blume further discloses that the system can be used for interactive applications, such as tests; the system can be used with children's books, foreign language instructional texts, books that introduce new vocabulary (technical, medical, legal, etc), provide speaking books for the visually impaired, and can be used for interactive applications, such as tests, automatically updated newspapers, and speed-reading training. For example, a multiple choice test may be printed on the special paper, such that a student simply selects their chosen answers by tapping on the selected answer. Audio feedback (such as through audio headphones) could be provided for purposes such as to give the definition of a

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word in a test question, or to confirm which answer the student has actually selected (all at 7:33-54). Examiner's position is that this is exactly what applicant defines as "an instruction". See specification at page 15, Para. 0068; a user may be "instructed" to write down words and be quizzed on them in a spelling test. Blume's use in a vocabulary test provides an audible instructional response of the definition of a word, as well as instructing the student to complete the test "task" by selecting the correct multiple choice answers. Claims are given their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Thus, Blume explicitly discloses mapping a position to a location in memory where an instructional response is stored, in response to determining a first position associated with a print element responsive to a user selection, wherein said instructional response is an instruction from the computing device for a user to use; and the instructional response relates to a task presented.

14. Third, even if the audio response of Blume was not clearly an "instruction" or a "task" to a user to turn the page, such audio content is simply non-functional descriptive material, such that a mere difference in the audio content between Blume and the instant invention would fail to patentably distinguish over Blume. Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in

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terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate."). Thus, audio is not a computer component. Protection for this type of work is provided under the copyright law. USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art, and may not disregard claim limitations comprised of printed matter. See *Gulack, Id.*; see also *Diehr*, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035; and *Ngai, Id.* See MPEP 2112.01(III). Thus, the audio provided by Blume anticipates the instructional response, being an instruction or a task, as recited in the instant claims, because any such differences are of non-functional descriptive material that fails to patentability distinguish over Blume.

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIKOLAI A. GISHNOCK whose telephone number is (571)272-1420. The examiner can normally be reached on M-F 11:00a-7:30p EST (8:00a-4:30p PST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

3/8/2010

/N. A. G./

Examiner, Art Unit 3715

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715